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GAZDZINSKI & ASSOCIATES
Suite 375
11440 West Bernardo Court
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OFFICE OF PETITIONS

Applicant: Richter, et al.
Appl. No.: 10/804,776
Filing Date: March 19, 2004
Title: METHOD AND APPARATUS FOR MULTIPLE MEDIA DIGITAL
COMMUNICATION SYSTEM
Attorney Docket No.: BTG.001C5
Pub. No.: US 2004/0218628 A1
Pub. Date: November 4, 2004

This is in response to "Applicant's Request for Reconsideration of its Request for Corrected Publication under 37 CFR 1.221(b)," which was received on April 14, 2005. Applicant requests that the above-identified application be republished with amended claims 71-166.

The request is DISMISSED.

The instant request is that the patent application publication, which published on November 4, 2004, be republished because inter alia the publication included a material error in that only a portion of claim 1 was published. Applicant states that the publication did not include claims 1-70, as originally filed or the claims as amended by the preliminary amendment filed with the application on March 19, 2004.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records . . . Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct 10, 2000) (final rule).

The patent application publication does not include a mistake in the publication by the Office, because the patent application publication included the claim as presented by Applicant on June 28, 2004, in response to the Notice to File Corrected Application Papers.

On March 19, 2004, the above-identified application was filed with claims 1-70 including a preliminary amendment canceling claims 1-70 and adding claims 71-166. The claims (original claims 1-70) did not commence on a separate sheet of paper as required by 37 CFR 1.52(b)(3) and 1.75(h). On June 2, 2004, the Office mailed a Notice to File Corrected Application Papers, requiring applicant to submit replacement claims commencing on a separate sheet in compliance with 37 CFR 1.75(h) and 1.121.

37 CFR 1.215(a) provides in part:

The patent application publication will be based upon the application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with §§ 1.72, application papers in compliance with §§ 1.52, drawings in compliance with §§ 1.84, or a sequence listing in compliance with §§§§ 1.821 through 1.825, except as otherwise provided in this section.

37 CFR 1.52(b)(3) provides in part:

The claim or claims must commence on a separate physical sheet or electronic page (§ 1.75(h)).

On June 28, 2004, in response to the preexamination notice, Applicant submitted a revised page 34 and 35, which deleted claim 1 from page 34 of the specification and only listed part of claim 1 on a separate sheet. The paper did not include a complete set of claims 1-70 commencing on a separate sheet and included only a portion of claim 1. The publication of that portion of claim 1 was thereafter consistent with submission in response to the notice and PTO rules. Thus, the request is appropriately dismissed.

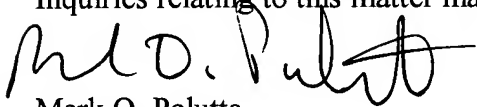
The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221 (a). Such a request for republication “must include a copy of the application compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18 (d) and the processing fee set forth in § 1.17 (i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18 (d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system and questions or request for reconsideration of the decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

By facsimile: 571-273-8300

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709 (voice).

A handwritten signature in black ink, appearing to read "M.O. Polutta", with a stylized flourish at the end.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy